

REMARKS

I. Petition Under 37 C.F.R. §1.136(a)

Pursuant to 37 C.F.R. § 1.136(a), applicants hereby petition for a one-month extension of the shortened statutory period set for reply to the Office Action dated September 5, 2008. The Commissioner is authorized to charge the \$130.00 fee set forth in 37 C.F.R. § 1.17(a)(1) or any other fees which may be required or credit any overpayment to Deposit Account No. 50-0417.

II. Introduction

Claims 1 - 31 and 71 are canceled.

Claims 32-70 and 72-78 are pending in this application.

Claims 32-70 and 72-78 are rejected.

Claims 79-103 are presented for examination.

Applicants more particularly point out the novelty of claims 79-103 in view of the state of the art disclosed by the cited references to comply with 37 C.F.R. § 1.111.

Applicants traverse these rejections based on the amendments above and the remarks set forth below. Reconsideration and allowance of the pending claims is respectfully requested.

III. Applicants' Reply to Rejection Under 35 U.S.C. §102(b)

Claims 32, 34, 68, and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,855,725 to Fernandez et al. ("Fernandez"). Applicants respectfully traverse.

Fernandez is purportedly concerned with a portable storage device ("CD book"), which stores several pages of content in its RAM and adds new content by transferring data from a CD-ROM database when the user reaches the last page of the previously stored content or requests a page not currently stored on the device. See, e.g., Fernandez, Abstract; column 2, lines 32-38; column 3, lines 8-24; column 7, lines 35-61; Figs. 2, 4, 5.

Claims 32-34

Claim 32 has been rejected as merely specifying a property of data shown in Fernandez and that the pending claims do actually not require the selection of content based on playback time as argued. (Pages 3-4 of Office Action, first paragraph).

Applicants respectfully disagree with both assertions. In the first instance, claim 32 does indeed specify selecting episodes having certain playback times. For example, claim 32 specifies "automatically selecting a subsequent episode ... wherein the subsequent episode is no greater than a predetermined playback time." Accordingly, applicants' claimed invention examines the playback time of a subsequent episode to

determine whether it qualifies for selection. By establishing a playback time threshold and excluding subsequent episodes that exceed that threshold, the invention recited in claim 32 does indeed select episodes having acceptable playback times, and therefore selects episodes based on their playback characteristics. Because applicants' claimed method makes selections based on playback time, the claim does not merely recite a property of the data, but rather makes decisions based data characteristics (which Fernandez does not do). Thus, applicants respectfully submit that claim 32 is allowable over Fernandez.

Moreover, with respect to the rejection regarding inherency based on the user's average time to read a page, applicants submit that this rejection is based on inaccurate analogies and assumptions. Initially, applicants point out that the system of Fernandez does not have any "playback time" associated with it at all. This is because the electronic book of Fernandez merely displays pages of a book on a video screen (for example, see Fernandez, column 7, lines 6-48) and therefore has no playback time associated with it.

In contrast, applicants' invention is concerned with digital content having an associated playback time (such as audio and/or video content). Because Fernandez merely renders pages of a book on an electronic display screen as prompted by a

user, the concept of playback time, or making decisions based on playback time, as specified in applicants' claims, are completely absent. Moreover, the rejection based on the average time to read a page is inapplicable for numerous reasons. For example, claim 32 specifies the amount of time it takes to playback certain digital content, which is a function of an electronic device as opposed to the function of a human (*i.e.*, average reading speed of a person). The claim specifies a selection criteria of acceptable content, not the reading ability of a user of an electronic book.

Further, this position also relies on the assumption that pages of Fernandez contain the same content, which is not the case, and such content variation greatly varies the reading speed of the average user (*e.g.*, a page may contain only a picture, table of contents, 36 point font, 4 point font, *etc.*). Thus, at least for the forgoing reasons, claim 32 is allowable over Fernandez. Claims 33-34 are allowable for at least the same reasons. Lastly, applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to claims 32-34.

Claims 68-69

Regarding claims 68-69, it appears the rejection is based on the correlation of a "page" of the electronic book of Fernandez with the content file specified in claim 68. See

Office Action dated May 19, 2006, page 3, second paragraph. Claim 68, as amended, now specifies updating a first content file when a part of the first content file is consumed. Based on the correlation drawn by the rejection, Fernandez would thus have to be capable of updating a portion of page. However, Fernandez is only capable of updating content on a "page-by-page" basis. See Fernandez, column 7 and Fig. 4. Because Fernandez is incapable of updating a partially consumed page (such as a partially consumed first content file) as specified in claim 68, claims 68 and 69 are allowable over Fernandez. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to claims 68-69.

Accordingly, at least for the above stated reasons, applicants respectfully request that the rejection of claims 32, 34, 68, and 69 under 35 U.S.C. § 102(b) be withdrawn.

IV. Applicants' Reply to Rejection under 35 U.S.C. §103(a)
Claims 33, 40-64, and 70

Claims 33, 40-64, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fernandez. Applicants respectfully traverse.

Applicants submit that claim 33 is allowable for at least the same reasons as independent claim 32, as explained above.

Furthermore, the rejection of claims 40, 46, 52, 57 and 70 has been maintained on the basis that the claims fail to specify where the titles are stored and that the claims require storing only one, not multiple titles. See Office Action, page 4, first full paragraph. However, in the February 9, 2006 Reply, at pages 5-6, applicants pointed out that Fernandez does not show or suggest replacing consumed media according to a user predetermined specification as recited in these claims. In that Reply, applicants further established that any design choice described in Fernandez relates to system limitations such as transmission rates and processing speed, and thus relate to configuration choices made by a system designer, not a user. The most recent Office Action has not responded to, or acknowledged this argument. Accordingly, applicants respectfully submit that claims 40, 46, 52, 57 and 70 are allowable over Fernandez for at least this reason. The foregoing notwithstanding, applicants have amended claims 40, 46 and 52 to make clear the claims are concerned with multiple titles and not just one title. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply with respect to these claims.

Thus, for at least the above stated reasons, applicants respectfully request that the rejection of claims 32, 34, 68, and 69 under 35 U.S.C. §103(a) be withdrawn.

Claims 35-39

Claims 35-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 5,761,485 to Munyan ("Munyan") in view of U.S. Patent No. 5,918,013 to Mighdoll et. al ("Mighdoll") and U.S. Patent No. 5,491,820 to Belove et. al ("Belove"). Applicants respectfully traverse.

Claim 35 specifies, among other things:

"a playback device to store and to playback the digital content coupled with the data retrieval device, the playback device to store a most-recent episode of a dynamically changing series of digital content, and to have the digital content automatically updated from the server device with a subsequent episode of the series of digital content to store on the playback device."

Neither Belove, Mighdoll nor Munyan, alone or in combination show or suggest these features.

For example, the rejection states that Munyan teaches a server to store and provide digital content and a playback device to store and play digital content. See August 12, 2005 Office Action, page 7. The rejection further indicates that Mighdoll shows a retrieval device which retrieves content on behalf of user devices and that the retrieval device automatically updates its content. *Id.*

However, in the system of Mighdoll, the updated content is stored on the intermediate retrieval device (proxy cache 65 on

server 5) *and not on the playback* device as specified in applicants' claims. See Mighdoll, column 11, line 50 to column 12 line 9; and column 4, line 40 to column 5, line 27 which explains that the purpose of updating the cache of potentially updated web pages is to reduce latency, help prevent propagation of outdated information from cache 65 to a system requesting information for the first time and ensure compatibility with the client's system. This has nothing at all to do with updating content in a playback device with a subsequent episode, but rather a network management tool. Accordingly, any updates are not on the playback device as specified in applicants' claims. Consequently, claims 35-39 are allowable over Munyan and Mighdoll.

The proposed combination of Belove and Munyan suffers from similar deficiencies. For example, the rejection indicates that Belove stores a most-recent episode of a dynamically changing series of digital content, and to have the digital content automatically updated from the server device with a subsequent episode of the series of digital content to store on the playback device. Applicants disagree. Belove explains that a user may select a folder of content and the system may issue a List Delta request which provides certain lists useful for updating the contents of the content folder based on a specific

update time provided by the client. See Belove, column 10, line 50 to column 11, line 17.

Once the content file is downloaded, however, another subsequent user initiated request is required to receive any subsequent updates to those content files. In contrast, applicants' claimed invention specifies *automatically* updating from the server with a subsequent episode. With the system of Belove, the user must again and again manually request the content folder in order to receive the benefit of another List Delta request. Once the content folder is received no further updates occur, whereas in applicants' claimed invention, updates of subsequent episodes are provided automatically without the need to request for the same content again. As a result, claims 35-39 are allowable over the proposed combination of Munyan and Belove. Applicants further restate and reiterate the reasons of allowance as set forth in the February 9, 2006 Reply.

Accordingly, in view of the foregoing, applicants submit that claims 35-39 are patentable over the Examiner's proposed combination Mighdoll, Munyan, and Belove and respectfully request that the rejection of claims 35-39 under 35 U.S.C. §103(a) be withdrawn.

Claims 65-67 and 72-78

Claims 65-67 and 72-78 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,442,390 to Hooper et al. ("Hooper"). Applicants respectfully traverse.

Hooper is purportedly concerned with a video-on-demand system, in which a selected video is transferred as video segments and stored in a memory buffer ("segment cache"), which includes a write pointer ("fill pointer") and a read pointer ("play pointer"). See, e.g., Abstract; column 2, lines 1-7; column 9, lines 45-48. The total number of video segments stored in the cache is fixed and depends on the type of video, but all segments are from a single video. *Id.*, column 10, lines 9-29.

In contrast, independent claims 65 and 75 specify a playback device including memory to store multiple digital content selections, logic to maintain a head pointer identifying a logical beginning of each selection in memory, and a content counter. Furthermore, Hooper does not store multiple content selections; at most, it stores several adjacent segments of the same video. Completely absent from Hooper is any teaching or suggestion on how to store or render segments relating to different content selections in the same segment cache. In fact, such features are not suggested or even recognized as desirable. Thus, the single video caching system of Hooper

teaches away from systems including plurality of different content selection as specified in applicants' claims.

Further, the rejection states that "it is well known in the art to provide device with multitasking capability or to let a view seeing two or more TV channels at a time." See Office Action date May 19, 2006, page 5. However, Hooper does not provide any teaching on how to accomplish this significant proposed modification. Nor is any other reference mentioned in the rejection which teaches how to accomplish the proposed modification. Such a modification may require additional hardware, software, data management protocols or procedures as well as additional controller(s) and corresponding logic to effect a content counter, discouraging the proposed combination. Hooper does not show or suggest how to effect any such modifications. Moreover, a mere assertion that the modifications or the prior art necessary to meet the claimed invention were separately known to one skilled in the art at the time the invention was made is insufficient to support a finding of obviousness. See *Ex parte Levengood*, 28 U.S.P.Q.2dc 1300 (Bd. Pat. App. & Inter. 1993). Applicants further restate and reiterate the reasons of for allowance over Hooper as set forth in the February 9, 2006 Reply. Accordingly, applicants respectfully submit that claims 65-67 and 72-78 are patentable over Hooper.

V. Claims 79-103

The following remarks more particularly point out the novelty of claims 79-103 in view of the state of the art disclosed by the cited references.

Independent claim 79 recites a method of "storing a plurality of digital content selections; maintaining a content counter for each of the plurality of digital content selections, wherein the content counter indicates a current location of consumption for corresponding digital content selection; and updating the content counters based on the consumption of the respective digital content selection."

Independent claim 81 specifies playback device including a plurality of digital selections stored in memory, logic to set a head pointer identifying a logical beginning and a tail pointer identifying a logical ending of each digital selection, and logic which provides a content counter, wherein the content counter is initially set to the head pointer of the corresponding digital selection and, wherein the content counter advances through the corresponding digital selection in memory during a consumption session.

Similarly, independent claims 93 is directed towards a method for storing and playing electronic content on a playback device including storing a plurality of digital selections

stored in memory, setting a head pointer identifying a logical beginning and a tail pointer identifying a logical ending of each digital selection; providing a content counter, wherein the content counter is initially set to the head pointer of the corresponding digital selection and, wherein the content counter advances through the corresponding digital selection in memory during a consumption session.

None of the features specified in these claims are shown or suggested by the cited prior art. For example, as mentioned above, Hooper describes video-on-demand system, in which a selected video is transferred as video segments and stored in a memory buffer, which includes a write pointer and a read pointer. The total number of video segments stored in the cache is fixed and depends on the type of video, but all segments are from a single video.

In contrast, independent claims 79, 81 and 93 specify systems and methods for storing multiple digital content selections, and content counters for tracking the current location and consumption of each of the multiple content selections. Claims 81 and 93 further specify maintaining a head pointer identifying a logical beginning of each selection in memory. Hooper does not store multiple content selections; at most, it stores several adjacent segments of the same video. Completely absent from Hooper is any teaching or suggestion on

how to store or render segments relating to different content selections in the same segment cache. In fact, such features are not suggested or even recognized as desirable. Thus, the single video caching system of Hooper teaches away from systems including plurality of different content selection as specified in applicants' claims.

Furthermore, applicants submit that Fernandez, Munyan, Mighdoll and Belove also fail to show or suggest these features for at least the reasons set forth herein. Accordingly, applicants respectfully submit that independent claims 79, 81 and 93, and the claims that depend therefrom are allowable over the prior art of record.

VI. Conclusion

For the foregoing reasons, applicants respectfully submit that the invention as claimed is patentable. Accordingly, reconsideration and allowance of pending claims 32-70, 72-78 and new claims 79-103 are respectfully requested. The Examiner is encouraged to contact applicants' undersigned representative to discuss any matter that may expedite prosecution of this case.

Respectfully submitted,

Date: November 3, 2008

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NYK 1184655-1.080293.0033